

Application No. 10/658,670

REMARKS

Claims 1-15 are pending. By this Amendment, claims 1, 3, and 13 are amended.

Claims 1 and 13 are amended to recite one of the limitations of claim 3 and claim 3 is amended to delete the limitation added to claims 1 and 13. No new matter has been added by the amendments to the pending claims. In view thereof, Applicant respectfully requests reconsideration and withdrawal of all rejections to the pending claims.

35 U.S.C. § 103

Claims 1-11, 13, and 15 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent 5,577,465 ("Cook") in view of U.S. Patent 5,743,412 ("Noble"). Applicant respectfully traverses this rejection. However, in order to advance the prosecution of this application, claims 1 and 13 are amended as stated above. In respectful contrast to the assertion regarding claim 3, Cook (nor Noble) discloses a non-terminal aperture. Cook, in fact has an end (i.e. terminal) opening 18, which receives a prong 24.¹

To establish a prima facie case of obviousness, a rejection must cite documents that teach or suggest all the claim limitations² and establish a proper motivation for modifying the documents cited against the claims.³ The motivation to modify the documents cited against the claims must be present in the documents themselves or otherwise in the prior art, not in the

¹ See Cook, column 2, line 51 *et seq.* ("The end openings 18 are typically round, but other shapes can also be used....Each corner member 14 has a center 22 and a plurality of prongs 24 directed outwardly from the center 22. Each prong 24 is sized and dimensioned to press fit into an end opening 18 in at least one of the beams 12.").

² See M.P.E.P. 2143 ("To establish a prima facie case of obviousness, the prior art reference (or references when combined) must teach or suggest all the claim limitations.").

³ See, M.P.E.P. § 2142 ("To establish a prima facie case of obviousness, ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. ... The teaching or suggestion to make the claimed combination ... must ... be found in the prior art, and not based on applicant's disclosure. *In re Vaack*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).").

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instant application^{4,5} and must be "clear and particular."⁶ Similarly, logic and sound reasoning in the absence of a motivation are also insufficient to establish a prima facie case of obviousness.⁷

Moreover, neither conclusory statements within the rejection nor subjective opinion stated in the rejection are sufficient to establish the required motivation to modify the documents cited against the claims.⁸ If the rejection asserts that the motivation was generally present in the art at the time of the invention, the Examiner may be required to execute an affidavit or declaration to that effect so that the Applicant may have the opportunity to explain or dispute the

⁴ See M.P.E.P. § 2142 ("The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure.").

⁵ Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985) ("Regarding an invention directed to a combination of known elements, the Board indicated that the examiner had done little more than cite references showing that elements or subcombinations of them were known. To support a conclusion of obviousness, 'either the references must expressly or impliedly suggest the claimed combination or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.'").

⁶ See In re Dembiczak, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[The] district court's conclusion of obviousness was error when it 'did not elucidate any factual teachings, suggestions or incentives from this prior art that showed the propriety of combination.' [citations omitted] ... The range of sources available, however, does not diminish the requirement for actual evidence. That is the showing must be clear and particular.") (emphasis added).

⁷ Ex parte Levengood, 28 USPQ2d 1300, 1302 (Bd. Pat. App. & Int. 1993) ("That one can reconstruct and/or explain the theoretical mechanism of an invention by means of logic and sound scientific reasoning does not afford the basis for an obviousness conclusion unless that logic and reasoning also supplies sufficient impetus to have led one of ordinary skill in the art to combine the teachings of the references to make the claimed invention.").

⁸ See In re Lee, 61 U.S.P.Q.2d 1430, 1434 (Fed Cir. 2002) ("The examiner's conclusory statements that the demonstration mode is just a programmable feature which can be used in many different device[s] for providing automatic introduction by adding the proper programming software and that another motivation would be that the automatic demonstration mode is user friendly and it functions as a tutorial do not adequately address the issue of motivation to combine. This factual question of motivation is material to patentability, and could not be resolved on subjective belief and unknown authority. It is improper, in determining whether a person of ordinary skill would have been led to this combination of references, simply to [use] that which the inventor taught against its teacher. W.L. Gore v. Garlock, Inc., 721 F.2d 1540, 1553, 220 USPQ 303, 312-13 (Fed. Cir. 1983). Thus the Board must not only assure that the requisite findings are made, based on evidence of record, but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.") (internal quotation marks omitted) (emphasis added).

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assertions therein.⁹ Additionally, evidence of patentability is established if the disclosures of the cited documents actually teach away from the asserted modification.¹⁰

Because neither Cook nor Noble disclose nor suggest the foregoing limitation, a prima facie case of obviousness has not been established with respect to claims 1, 10, and 13. The other rejected claims depend from one of claims 1, 10, or 13. Therefore, a prima facie case of obviousness has not been established with respect to the other rejected claims as well. Applicant further submits that a motivation to modify the disclosure of Cook with the disclosure of Noble has not been established. Because a prima facie case of obviousness has not been established against the rejected claims, reconsideration and withdrawal of the rejection is respectfully requested.

Claims 12 and 14 are rejected under 35 U.S.C. § 103(a) as unpatentable over Cook in view of U.S. Patent 5,709,164 ("Batterton"). Applicant respectfully traverses this rejection. However, claims 1 and 13 are amended as described above. In addition to Cook and Noble, Batterton also fails to disclose or suggest the limitations in claims 1, 10, and 13 as described above.

Therefore, claims 12 and 14, depending from respective claims 10 and 13, are not obvious as well because a prima facie case has not been established as shown above. Because a

⁹ See M.P.E.P. § 2144.03 ("As the court held in Zurko, an assessment of basic knowledge and common sense that is not based on any evidence in the record lacks substantial evidence support. In re Zurko, 59 USPQ2d 1693, 1697.... If the examiner is relying on personal knowledge to support the finding of what is known in the art, the examiner must provide an affidavit or declaration setting forth specific factual statements and explanation to support the finding. See 37 CFR 1.104(d)(2) ["When a rejection in an application is based on facts within the personal knowledge of an employee of the Office, the data shall be as specific as possible, and the reference must be supported, when called for by the applicant, by the affidavit of such employee, and such affidavit shall be subject to contradiction or explanation by the affidavits of the applicant and other persons"].") (emphasis added).

¹⁰ See MPEP § 2155.05 III ("A prima facie case of obviousness may also be rebutted by showing that the art, in any material respect, teaches away from the claimed invention. In re Geisler, 116 F.3d 1465, 1471, 43 USPQ2d 1362, 1366 (Fed. Cir. 1997)").

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prima facie case of obviousness has not been established, reconsideration and withdrawal of the rejection is respectfully requested.

In view of the foregoing, it is submitted that this application is in condition for allowance. Favorable consideration and prompt allowance of the application are respectfully requested.

The Examiner is invited to telephone the undersigned if the Examiner believes it would be useful to advance prosecution.

Respectfully submitted,



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